

**O/0843/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. UK00003600325  
IN THE NAME OF H.J. HEINZ FOODS UK LIMITED  
FOR THE FOLLOWING MARK:**

**SOSU**

**IN CLASSES 29 AND 30**

**AND**

**IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF  
INVALIDITY THERETO  
UNDER NO. 505265  
BY HERBA RICEMILLS, S.L.U.**

## Background and pleadings

1. H.J. Heinz Foods UK Limited (“the proprietor”) is the owner of the trade mark shown on the cover page of this decision (“the contested mark”). The contested mark was filed on 24 February 2021 and registered on 30 July 2021. The contested mark stands registered for the following goods:

**Class 29:** *Prepared meals and savoury snacks; prepared meals consisting primarily of meat, meat substitutes, fish, eggs or vegetables; snack foods included in class 29.*

**Class 30:** *Cooking sauces and pastes; savoury sauces, chutneys and pastes; prepared meals consisting primarily of rice, noodles or pasta; noodles; rice; dumplings; pasta; snack foods included in class 30; sauces; table sauces; spices; spice extracts; spice mixes; mixed spices.*

2. On 10 August 2022, HERBA RICEMILLS, S.L.U. (“the applicant”) applied for a declaration of invalidity against the contested mark based upon Sections 47 and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The application is targeted at the contested mark’s specification in class 30 with the applicant relying upon the following trade marks:<sup>1</sup>

UK00900011890 (the 1890 mark)



**SOS**

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<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the applicant having two EUTMs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retains their original filing dates.

Filing date: 01 April 1996; Registration date: 02 February 1998

Under this mark the applicant relies upon some of the goods for which the mark is registered, namely *rice, preparations made from cereals* in Class 30.

UK00913045125 (the 5125 mark)



Mark Description/Limitation: Colour Claimed : blue; red.

Filing date: 01 July 2014; Registration date: 28 October 2014

Under this mark the applicant relies upon some of the goods for which the mark is registered, namely *rice, preparations based on rice, prepared dishes in which rice is the main ingredient; preparations made from cereals* in Class 30.

3. By virtue of their earlier filing dates, the trade marks upon which the applicant relies qualify as earlier trade marks pursuant to Section 6 of the Act. As both earlier marks had completed their registration process more than 5 years before the application for a declaration of invalidity, they are both subject to proof of use pursuant to Section 6A of the Act.

4. The applicant claims that the marks are highly similar and that the goods are identical or similar, with the result that there is a likelihood of confusion.

5. The proprietor filed a counterstatement denying the claims made and requesting proof of use of the applicant's marks.

6. The proprietor is represented by Bird & Bird LLP and the applicant is represented by Keltie LLP.

7. Only the applicant filed evidence. No hearing was requested and both parties elected to file submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers.

### **The evidence**

8. The applicant's evidence consists of a witness statement by Luis Pena Pazos, who is the joint administrator and sole shareholder of the applicant's company. Mr Pazos' witness statement is dated 6 February 2023 and is accompanied by six exhibits (exhibits 1 – 6).

### **Relevance of the EU Law**

9. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **DECISION**

10. Section 5 of the Act has application in invalidation proceedings by virtue of Section 47 of the Act. Section 47 of the Act reads as follows:

47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

11. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

## **PROOF OF USE**

12. I will begin by assessing whether there has been genuine use of the earlier marks. As explained in the above legislation, there are two relevant periods. The first is the period of 5 years ending with the date of the application for invalidity, namely 11 August 2017 to 10 August 2022 and the second is the period of 5 years ending with the filing date of the contested mark, namely 25 February 2016 to 24 February 2021.

13. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

16. Because the earlier marks are comparable marks, paragraph 9 of Part 1, Schedule 2A of the Act is also relevant. This provision means that use in the EU will be relevant for any part of the relevant periods which fall prior to IP Completion Day (i.e. 31 December 2020). For those parts of the relevant periods which fall after that date, only use in the UK will be relevant.

17. The main points from Mr Pazos’ evidence can be summarised as follows:

- The ‘SOS’ mark has a long history having been created in 1903 as a brand for rice;
- The ‘SOS’ mark has been in continuous use in Spain since 1903 and has a substantial share of the rice market;
- ‘SOS’ branded goods are sold throughout the main Spanish supermarkets across the whole of Spain;
- The table below shows the turnover, the volume, and the market share relating to the sale of ‘SOS’ branded goods in Spain for the years 2016-2021:

			ROUND KG	ROUND €	WHOLEGRAIN KG	WHOLEGRAIN €
	SOS TOTAL €	SOS TOTAL TM.	SHARE	SHARE	SHARE	SHARE
2016	31.884.710,50	20.315,35	17,8	28,9	31,1	32,6
2017	32.313.569,40	20.636,86	18,5	29,3	29,6	31,1
2018	36.909.226,80	23.271,53	20,7	30,5	29,7	30,6
2019	38.558.884,70	24.259,56	21,8	31,5	27,1	27,7
2020	49.704.652,20	30.821,92	23,7	32,9	29,2	29,5
2021	45.124.072,40	27.673,56	23,0	32,2	25,7	26,3

As it can be seen, between 2016 and 2021 the applicant sold a total of over €231million worth of goods, with annual sales ranging between €32million and €50million. This equated to a market share of between 20% and 30% of the Spanish market for the relevant goods;

- Promotion of the ‘SOS’ mark includes advertisements in magazines, on TV or radio and advertisements on the internet. The table shown below indicates an annual advertising spend of approximately €1million between 2018 and 2022 (with the exception of 2020) for a total of around €5million. This is said to relate to advertising and promotional expenditure for rice and other products:

Year	Television	Radio	Internet	Magazines	Press	External
2018	Euro 873.638		Euro 126,321			
2019	Euro 1,162,400		Euro 149,531	Euro 17,000		
2020		Euro 26,000	Euro 85,871		Euro 7,000	
2021	Euro 888,035		Euro 101,451			
2022	Euro 1,126,116		Euro 259,656			Euro 20,002

18. The supporting exhibits introduced by Mr Pazos include a copy of a EUIPO decision (translated) dated 21 November 2022 relating to an opposition (B3148800) brought by the applicant in these proceedings against a third-party mark.<sup>2</sup> The opposition was based upon two Spanish trade mark registrations, one for the word-only mark ‘SOS’ and the other for a figurative mark that appears identical to the applicant’s 1890 mark, with both registrations being protected for, inter alia, *rice* and *preparations made from cereals*. In his witness statement, Mr Pazos pointed out that the EUIPO’s decision concluded that the applicant’s marks had been put to genuine use during the relevant 5 year period (which, in that case, run from September 2016 to September 2021) throughout Spain and that the applicant’s marks had a substantial share of the rice market. I note, in particular, the following passages of the decision:

*“From the evidence presented it can be deduced that the earlier marks have been subject to prolonged and intensive use in Spain and that they enjoy a widespread reputation in the relevant market, in which ‘SOS’ occupies a*

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<sup>2</sup> Exhibit 3

*consolidated position for rice. This conclusion has been confirmed by independent and diverse sources (invoices, presence in Spanish programs, studies on the brand in question, etc.). Thus, the information on the prominent place that the brand occupies in the rankings published by independent companies at the Spanish level are, without a doubt, proof of the recognition of the brand in the market. The tests shows that a significant part of the relevant public recognizes "SOS" as a brand of rice marketed under it. Likewise, it is worth taking into account the different references in the press, which are circumstances that show that the brand enjoys a significant level of diffusion and recognition among the Spanish public.*

*As regards the intensity of the reputation of the earlier mark, the Opposition Division takes into account, in particular, its intensive use in Spain. In view of the evidence provided, the Opposition Division concludes that they are sufficient to assess the reputation of the earlier marks and show that the use of "SOS" for rice is old and long-standing.*

*In such circumstances, the Opposition Division considers that the evidence provided by the opponent indicates that the earlier marks enjoy a reputation in Spain, to a high degree, in relation to rice"*

19. Mr Pazos also provides copies of invoices dated within the relevant period (without translation) showing, among others, sale of goods identified by the brand 'SOS' in the product description.

### **Conclusion on proof of use**

20. In is submissions in lieu the proprietor quite rightly pointed out that the applicant relies on summaries of evidence filed in entirely separate proceedings which is not evidence at all. I agree with the applicant that annotating a previous proof, by producing decisions that summarise evidence filed in separate proceedings, is not a very helpful way of approaching the evidence. If the applicant wished to rely on evidence filed in separate proceedings, it should have produced the same evidence in these proceedings.

21. Having said that, Mr Pazos provides specific evidence of basic facts such as turnover figures, marketing spend, market share and examples of invoices, all relating to, or dated within, the relevant periods, which I have no reason to disbelieve. This evidence, even taken on its own, builds a picture of the applicant's 'SOS' rice as a leading brand product sold in Spain. What the evidence relating to the other proceedings does, is to reinforce something that is already established by Mr Pazos' witness statement in a far more concise format. Whilst the EUIPO's decision is not obviously binding on me, it has some persuasive value for present purposes of establishing genuine use.

22. The applicant also argues that the turnover figures are not broken down by product and cannot be taken to refer the goods for which genuine use must be shown. Whilst it would have been better if Mr Pazos had clarified that the turnover figures relate to rice, I think it is reasonable to assume that they do because: 1) there is a mention at the beginning of Mr Pazos' witness statement that the purpose of his evidence is to demonstrate genuine use of the earlier mark(s) in relation to *rice and preparations made from cereals*; (2) the table providing turnover figures and market share refers to the figures in Kg rather than units and rice would be sold in Kg, (3) most of the invoices produced in evidence shows use of the mark 'SOS' in relation to rice (arroz) and other products sold in gr and/or Kg that appear to refer to ready-made meals based on rice, such as for example, paella.

23. Another criticism advanced by the proprietor is that the applicant's evidence shows the earlier marks in a form other than that under which they had been registered. Admittedly, the only evidence filed by applicant which shows use of the mark 'SOS' within the relevant periods is provided by the invoices; they show the mark 'SOS' listed in the product description, for example, within the phrase "ARROZ SOS" (the word 'arroz' meaning 'rice' in Spanish) but without the figurative elements.

24. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under Section 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD

MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

25. In *Menelaus BV v EUIPO*, Case T-361/13, the General Court (“GC”) found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



26. The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73. [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74. That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

27. Applying the above guidance, I find that the dominant and distinctive element of the applicant's marks is the word 'SOS'. The graphic figurative elements of the marks are merely ornamental and/or descriptive, representing what appear to me to be two women in traditional Spanish costumes and the stylised image of a rice plant. I therefore find that the absence of the figurative elements of the marks can be considered a minor change that do not alter the distinctive character of the trade marks, in the manner in which they have been registered.

28. Finally, the proprietor states that the evidence is not sufficient to establish genuine use because the use of the mark in Spain does not count toward genuine use for the part of relevant periods that falls after 31 December 2020. I reject the argument. Proof of use must show 'genuine use' of the mark during the relevant 5 year period. Whilst the registration of a trade mark is liable to be revoked if the trade mark has not been used after the date of registration within an uninterrupted period of 5 years, the legislative provisions about revocation affect only trade marks the genuine use of which has been suspended for an uninterrupted period of five years. Therefore, it is sufficient for a trade mark to have been genuinely used for part of the relevant period in order to escape those sanctions.<sup>3</sup> In this case, use of the mark in Spain covers nearly the entirety of the second relevant period, and at least half of the first relevant period.

29. Therefore, taking all of the evidence as a whole, I am satisfied that the earlier marks have been put to genuine use in relation to rice during the relevant periods in the EU.

30. Whilst there is no specific evidence of use in relation to *preparations made from cereals*, the evidence refers to the applicant offering rice-based dishes including paella, rice with quinoa, and rice-based salads, a fact which is supported by invoices. Consequently, I consider a fair specification of the earlier marks to be *rice and prepared dishes in which rice is the main ingredient*.

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<sup>3</sup> *MFE Marienfelde v OHMI- Vétuquinol (HIPOVITON)*, Case T-334/01 (08 July 2004)

## Section 5(2)(b) – case-law

31. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

32. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

33. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

34. The GC confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

35. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking.”

36. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

37. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”

38. The goods to be compared are as follows:

<b>The contested goods</b>	<b>The applicant’s goods</b>
<b>Class 30:</b> <i>Cooking sauces and pastes; savoury sauces, chutneys and pastes; prepared meals consisting primarily of rice, noodles or pasta; noodles; rice; dumplings; pasta; snack foods included in class 30; sauces; table sauces; spices; spice extracts; spice mixes; mixed spices.</i>	<b>Class 30:</b> <i>rice, prepared dishes in which rice is the main ingredient.</i>

39. As it will be recalled, the applicant has not shown genuine use of the marks in relation to *preparations made from cereals* and it cannot rely on these goods. I will therefore disregard the applicant's arguments based on the similarity between the proprietor's goods and the registered *preparations made from cereals*.

40. In its submissions in lieu, the applicant states that there is some overlap between the goods in terms of complementarity as some of the contested goods (*cooking sauces and pastes; savoury sauces, chutneys and pastes; sauces, table sauces; spices; spice extracts; spice mixes; mixed spices*) are used to create a meal or flavour rice and may be complementary to rice.<sup>4</sup> The applicant also states the goods are similar because they are all food products and so they share the same purpose, distribution channels and consumer. I reject these submissions. First, the facts that different types of foodstuffs can be used as ingredients in a recipe does not make the goods similar from a trade mark perspective. Even less, the fact that the goods are all foodstuffs does not make them necessarily similar.

41. Turning to the proprietor's position, in its submissions in lieu the proprietor admitted that the contested "*meals consisting primarily of rice; rice; snack foods included in class 30*" are similar to the applicant's goods. However, since the proprietor did not say to what extent it considers the goods to be similar, I will examine the relevant factors to determine the level of similarity of these goods.

42. Rice is identically included in both lists of goods. **These goods are identical.**

43. The applicant's *prepared dishes in which rice is the main ingredient* are **identical** to the contested *prepared meals consisting primarily of rice*. The applicant's *prepared dishes in which rice is the main ingredient* are also **similar to a medium degree** the contested *prepared meals consisting primarily of noodles or pasta* as the goods have the same nature (they are prepared meals), and purpose, target the same consumers,

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<sup>4</sup> In its submissions in lieu the applicant refers to goods which are not listed in the proprietor's specification, including *wheat-based snack foods; corn-based snack foods; pasta-based snack foods; bread-based snack foods*. I have checked the specification in class 30 which reads: *Cooking sauces and pastes; savoury sauces, chutneys and pastes; prepared meals consisting primarily of rice, noodles or pasta; noodles; rice; dumplings; pasta; snack foods included in class 30; sauces; table sauces; spices; spice extracts; spice mixes; mixed spices* and it is clear that it does not contain the terms to which the applicant refers. I can only conclude that this was due to an error and the submissions not having been checked against the registered specification in class 30 which is under attack.

will be sold in close proximity in supermarkets, and are in competition, as consumers might choose between a prepared meal consisting primarily of rice and a prepared meal consisting primarily of noodles or pasta.

44. The contested noodles; dumplings; pasta can replace the applicant's *rice*. Although the goods have a different nature, they have a similar purpose, target the same consumers, will be sold in close proximity in supermarkets, and are in competition. These goods **are similar to a medium degree**.

45. The contested snack foods included in class 30 include snacks made from rice, such as rice cakes. The goods have a similar nature (they are rice or products made from rice) but have a different purpose, as rice cakes are purchased as a snack and rice is purchased as an ingredient used to prepare a meal or a dish. These goods are similar to **a medium degree**.

46. The contested savoury sauces, chutneys and pastes; table sauces; spices; spice extracts; spice mixes; mixed spices are dissimilar to the applicants' *rice* and *prepared meals consisting primarily of rice*. The nature, purpose and method of use of the goods are different, the goods are neither complementary nor in competition. While they can occasionally share distribution channels and end users, this factor alone is not sufficient to establish an adequate degree of similarity between the goods. For these reasons, these goods are deemed to be **dissimilar**.

47. The proprietor's sauces; cooking sauces and pastes are similar to a low degree to the applicant's *rice*. Although the goods have a different nature and purpose, they can be complementary to the extent that they can be used to create a dish, for example, an Indian or Chinese rice-based dish which incorporates a cooking sauce. Further, from my experience the goods have converged in the UK market in such a way that they will be perceived as complementary, and are normally sold in the same aisles of supermarkets. These goods are **similar to a low degree**.

## **Average consumer**

48. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49. The average consumer of the goods at issue is a member of the general public. The purchasing process for these goods is likely to be dominated by visual considerations. However, I do not discount aural considerations entirely as it is possible that the purchasing of the goods would involve oral discussions with sales representatives or word of mouth recommendations.

50. As regard the degree of attention, I consider that it would be lower than normal given that the goods are inexpensive and purchased very frequently. However, given that the goods will be eaten, I do not consider that there will be the lowest level of attention from the average consumer. I consider that the average consumer will pay a degree of attention between low and medium.


## **Comparison of marks**

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

52. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The proprietor's mark	The applicant's mark
<p><b>SOSU</b></p>	

### The opponent's submissions

53. In its submission in lieu the applicant states that (a) the word 'SOS' is the dominant and distinctive component in the earlier marks due to its size and distinctiveness, (b) the additional letter "U" in the proprietor's marks "*does not do enough to sufficiently differentiate the marks*", (c) overall, the marks are similar to a high degree and (d) the marks have no meaning and there is no hook to hang a conceptual distinction on neither mark.

54. The applicant also refers to the fact that consumers will, as a general rule, pay more attention to the beginning of marks.

55. Finally, the applicant invites me to take into consideration the following passage from the General Court's decision in the case of *Rod Leichtmetallrader v OHMI - Rodi TR (ROD)* - T-75/15:

"41. Secondly, as regards the alleged differences in the length of those word elements, it must be stated that a difference of only one letter and of only one syllable is not such as to counteract the similarity found in paragraph 37 above. In that regard, the applicant is incorrect in stating, relying on the judgment of 11 May 2005 in *CM Capital Markets v OHIM — Caja de Ahorros de Murcia (CM)* (T-390/03, ECR, EU:T:2005:170), that a difference of one letter has a greater impact in the case of short words than in the case of long words. No such proposition is set out in that judgment.

42. Similarly, as regards the different typefaces of the words 'rod' and 'rodi', it must be stated that these do not constitute a significant difference likely to attract the attention of the relevant public, since both signs have large capital letters that are quite banal in style.

43. Consequently, in the light of the case-law cited in paragraphs 38 and 39 above, the Court is of the view that the Board of Appeal was fully entitled to find, in paragraphs 20 and 21 of the contested decision, that the elements that

differentiate the marks, considered as a whole, do not outweigh those marks' common element 'rod'."

### The applicant's submissions

56. In its submission in lieu the proprietor argues that (a) the figurative and the word elements of the earlier marks take equal prominence (b) even ignoring the device element, there is a clear difference between the three letters 'SOS' and the four letters 'SOSU' (c) with short marks, any additional elements make a significant difference, especially where the additional element changes the way the mark will be perceived (d) the applicants' marks will be read as three letters 'SOS' and understood as an acronym for the well-known expression "save our souls", meaning it will be seen as a three letter acronym rather than a word, whilst the proprietor's mark will be read as a word and not considered as an acronym (e) the marks are visually, aurally and conceptually dissimilar.

### **The overall impression**

57. The applicant's mark consists of the word 'SOSU'. There are no other elements that contribute to the overall impression, which lies in the word itself.

58. As it will be recalled, I have concluded that the dominant and most distinctive element of the proprietor's mark is the word 'SOS' with the figurative elements having less weight in the overall impression due to their descriptive and ornamental nature and their smaller size. The figurative elements carry therefore relatively little weight in the comparison of the marks at issue.

### **Visual similarity**

59. Visually, the marks coincide in the first three letter 'SOS' and differ in the presence of the letter 'O' at the end of the contested mark, which has no counterpart in the applicant's marks. Further, the case-law relating to the significance of the first component of a word mark is applicable in the present case. The verbal elements of the marks are in my view similar to an above medium (but not high degree). Although

the figurative elements of the earlier marks somewhat reduce the visual similarity between the signs to medium, it does not neutralise the similarity created by the word elements of the marks.

### **Conceptual similarity**

60. I now turn to consider the conceptual similarity because the meaning conveyed by the marks will, in my view, affect their pronunciation.

61. The applicant states that the verbal element of the earlier marks will be understood as a call for help. Admittedly, the Collins online dictionary gives the meaning of SOS as follows:

*a signal which indicates to other people that you are in danger and need help quickly*

*an internationally recognized distress signal in which the letters SOS are repeatedly spelt out, as by radiotelegraphy: used esp by ships and aircraft*

*a message broadcast in an emergency for people otherwise unobtainable*

*informal*

*a call for help*

62. It also refers to the word origin as follows: “C20: letters chosen as the simplest to transmit and receive in Morse code; by folk etymology taken to be an abbreviation for save our souls”.

63. Whilst the letters ‘SOS’ might have the meaning of an abbreviation or a code which is used as a call for help, it normally refers to a message sent by ships and aircraft using radiotelegraphy. However, I am not convinced that the relevant consumer will give the letters ‘SOS’ that meaning in the context of the goods at issue.

64. In my view, the average consumer of rice, who encounters the earlier marks on a package of rice, will not understand 'SOS' as conveying the message of Morse code distress signal, but rather as an invented word denoting the name of the producer of the rice. In other words, whereas the word 'SOS' might convey the message of a request for help in the context of certain types of goods, for example lifesaving apparatus, it seems to me that when that word is applied to a package of rice it will lose that meaning. Further, I bear in mind that the element 'SOS' represents a very short sequence of letters and that customers are used to see abbreviations and acronyms used in trade marks, with the result that the distinctiveness of the sequence 'SOS' is not particularly striking and, absent any other clues deriving from the marks and/or the goods at issue, the average consumer is unlikely to perceive 'SOS' on a package of rice in the way described by the proprietor. Finally, the figurative elements of the marks, if anything, contribute to create an overall impression that will further distance the verbal element 'SOS' from the meaning of a Morse code distress signal.

65. Consequently, I agree with the applicant that the word 'SOS' in the earlier marks will be perceived as an invented word with no meaning. Likewise, the word 'SOSU' has no meaning in English and will be perceived as an invented word. As neither word will be perceived as having a meaning, a conceptual comparison is not possible.

### **Aural similarity**

66. Given my finding that the sequence 'SOS' in the applicant's mark will not be perceived a Morse code distress signal, it will be pronounced as a word rather than as three separate letters. Consequently, I find that the marks will both be articulated as the words 'SOS' and 'SOSU' and are aurally similar to a medium degree.

### **Distinctive character of earlier mark**

67. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

68. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

69. The applicant’s marks consist of the single word ‘SOS’ and figurative elements that are low in distinctiveness. I have already found that ‘SOS’ will be perceived as three-letter sequence with no meaning. Although the sequence is neither descriptive nor allusive of the goods at issue, it is very short and, in my view, it is distinctive to a low to medium degree.

70. In its submission in lieu, the applicant argued that the distinctiveness of its ‘SOS’ trade marks has been significantly enhanced as a result of the exposure to the relevant public through advertising campaigns in Spain. This submission is wrong in law. Although the applicant has provided evidence of use of the mark ‘SOS’, it is all use

outside the UK and therefore it cannot show that the mark has acquired an enhanced level of distinctive character through use in the UK.

### **Likelihood of confusion**

71. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

72. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

73. Earlier in this decision, I found as follows:

- The goods vary from being similar to a low degree to being identical (except where I have found them to be dissimilar);
- The average consumer is a member of the general public who will select the goods visually paying a low to medium degree of attention;
- The marks are visually and aurally similar to a medium degree. Conceptually the words 'SOS' and 'SOSU' will be perceived as invented words with no meaning;
- The earlier mark is inherently distinctive to a low to medium degree.

74. In my view, taking into account the similarity between the marks and the low to medium degree of attention the average consumer will pay when selecting the goods, there is a risk of the average consumer directly confusing the marks when identical goods are involved.

75. However, I am satisfied that when less similar goods are involved, the distance between the goods, combined with the lower-than-normal degree of distinctive character of the earlier marks, will be sufficient to offset the similarity of the marks, and there will be no likelihood of confusion.

### **Final remarks**

76. For the sake of completeness, I should say that even if I had found that a proportion of the relevant public would understand the meaning of 'SOS' in the earlier marks as a request for help, I would still find that the conceptual differences between the mark would not overcome their visual and aural similarities in the context of identical goods. In *Nokia Oyj v OHIM*, Case T 460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established

(see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

77. In a similar vein, in the decision BL-O/566/19 Mr Geoffrey Hobbs QC, sitting as the Appointed Person, overturned a decision that the conceptual differences between the marks ‘PIMKIE’ and ‘PINKIE’ were sufficient to outweigh the visual and aural similarities between them.

78. Whilst I bear in mind that Mr Hobbs’ decision referred to different marks, it demonstrates the soundness of the principle that conceptual differences do not always overcome visual or aural similarities. That would be the case here.

## **CONCLUSIONS**

79. The application for invalidation is successful in relation to the following goods for which the proprietor’s mark is deemed never to have been made:

**Class 30:** *prepared meals consisting primarily of rice; rice.*

80. The application for invalidation is unsuccessful in relation to (or it was not directed against) the following goods for which the proprietor’s mark can remain registered:

**Class 29:** *Prepared meals and savoury snacks; prepared meals consisting primarily of meat, meat substitutes, fish, eggs or vegetables; snack foods included in class 29.*

**Class 30:** *Cooking sauces and pastes; savoury sauces, chutneys and pastes; prepared meals consisting primarily of noodles or pasta; noodles; dumplings; pasta; snack foods included in class 30; sauces; table sauces; spices; spice extracts; spice mixes; mixed spices.*

81. As both parties have enjoyed a degree of success, I decline to make an award of costs.

**Dated this 6<sup>th</sup> day of September 2023**

**Teresa Perks  
For the Registrar**